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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,933	01/07/2004	Peter M. Bonutti	2500DV2CN2DV3CN8	5806

7590 01/24/2007
Patent Counsel
United States Surgical, a division of
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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/752,933

Applicant(s)

BONUTTI, PETER M.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Jan. 8, 2007 has been entered.

Claims 1 and 4-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, lines 8-9 are confusing and inaccurate since the lumen of "said inflatable bladder including a lumen" would appear to be only that portion of the lumen that it within the bladder, since that the portion of the lumen that is not within the bladder is not part of the bladder. However, the portion of the lumen that it within the bladder does not extend to a proximal end of the retractor as claimed.

Claims 1-9, 11 and 12 rejected under 35 U.S.C. 102(b) as anticipated by or; in the alternative, under 35 U.S.C. 103(a) as obvious over Simpson et al. (4,323,071). Simpson et al. disclose cannula 21 and a retractor including shaft 37, 38 and inflatable bladder 43, the inflatable bladder 43 including a

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lumen (the lumen within member 37) extending therethrough (noting that a portion of the lumen within member 37 extends through bladder 43), the lumen connecting a proximal end of the retractor with the working space such that a surgical instrument is introducible into the working space. The bladder 43 is inherently capable of retracting opposed surfaces of a bone joint since the inflation of the bladder would inherently apply an outward pressure against the opposed surfaces to retract them. Alternatively, it would have been obvious that inflatable bladder 43 is capable of retracting opposed surfaces of a bone joint for the reasons set forth above. As to claim 4, bladder 43 is eccentrically mounted on the shaft when it is in the configuration shown in dashed lines in figure 6B. As to claim 5, any stretching of the bladder 43 will be finished when it is fully inflated. As to claims 6 and 7, note col. 9, lines 64-68 of Simpson et al. and note that 1 atmosphere equals 760 mmHg. As to claim 8, member 66 may be considered to be part of the shaft. This portion 66 of the shaft is rigid. As to claim 11, Simpson et al. disclose an interventional instrument 116.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (4,323,071) in view of Mecca (4,690,140). Simpson et al. fail to disclose a viewing scope. However, Mecca teaches that a viewing scope (figure 10) should

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be inserted into guide member 1 apparently in order to obtain the advantage of viewing the interior of a blood vessel being treated. It would have been obvious to include a viewing scope in the Simpson et al. guide wire (described in col. 9, lines 45-64) so that it too would have this advantage.

Applicant's arguments with respect to claims 1 and 4-12 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571) 272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

mht



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731